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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,452	04/16/2001	Karl Reimer	23541-7002	5862
22854	7590	08/22/2006		
MOORE, HANSEN & SUMNER, PLLP 225 SOUTH SIXTH ST MINNEAPOLIS, MN 55402				
			EXAMINER WONG, EDNA	
			ART UNIT 1753	PAPER NUMBER

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/836,452

Applicant(s)

REIMER, KARL

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 92-97, 101-115 and 119-135 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 92-97, 101-115 and 119-135 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

This is in response to the Amendment dated July 17, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments***

#### **Claim Objections**

Claim **128** has been objected to because of minor informalities.

The objection of claim 128 has been withdrawn in view of Applicant's amendment.

#### **Claim Rejections - 35 USC § 112**

Claims **115, 119-120 and 127** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 115, 119-120 and 127 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendment.

#### **Claim Rejections - 35 USC § 102**

Claims **92-94** have been rejected under 35 U.S.C. 102(b) as being anticipated by **DE 36 31 123 A1** ('123).

The rejection of claims 92-94 under 35 U.S.C. 102(b) as being anticipated by DE

36 31 123 A1 ('123) is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant states that DE '123 discloses a two-part procedure in which parts are aggressively cleaned with heated solvents in a first step and then irradiated in a second step with UV radiation for 15 to 30 minutes to achieve desired results for better adhesion to shoe pads.

In response, the claims as presently written are open to a cleaning step and irradiating the UV radiation for 15 to 30 minutes.

Applicant states that there is no disclosure of a conveying mechanism and the radiation dosage level does not appear to be mentioned.

In response, there is no conveying mechanism and radiation dosage level recited in these claims. It is well settled that unpatented claims are given the broadest, most reasonable interpretation and that limitations are not read into the claims without a proper claim basis therefor. *In re Prater* 415 F. 2d 1393, 162 USPQ 541 (CCPA 1969); *In re Zeltz* 893 F. 2d 319, 13 USPQ 1320.

Applicant states that as previously noted, the present claims are directed to a one step process in which substrates are exposed to continuous UV radiation.

In response, the phrase "consisting essentially of" limits the scope of a claim to the specified steps and those that do not materially affect the basic and novel

Art Unit: 1753

characteristic of a method. When Applicant contends that modifying steps in the reference method are excluded by the recitation of "consisting essentially of", Applicant has the burden of showing the basic and novel characteristics of his method, i.e., a showing that the introduction of these steps would materially change the characteristics of Applicant's method. *In re Lajarte* 337 F 2d 870, 143 USPQ 256 (CCPA 1964).

#### Claim Rejections - 35 USC § 103

I. Claims **92-97, 101-107 and 113-114** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Drzal et al.** (US Patent No. 6,565,927 B1).

The rejection of claims 92-97, 101-107 and 113-114 under 35 U.S.C. 103(a) as being unpatentable over Drzal et al. is as applied in the Office Actions dated June 3, 2005 and January 18, 2006 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant states that it is respectfully submitted that Drzal does not teach continuous radiation. It is respectfully submitted that simply mentioning in the abstract that the light can be pulse or continuous is not a teaching of the use of both pulsed and continuous light if there is no further explanation of how to use continuous light.

In response, if it is not a teaching, then what is it? A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied*, 469 U.S. 851 (1984). A reference may be

Art Unit: 1753

relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989) and MPEP § 2141.02 and MPEP § 2123.

Applicant states that Drzal only explains how to use pulsed light and does not mention how to use continuous light in the specification where an elaborate description is provided of how to use pulsed light.

In response, it is within the level of ordinary skill in the art to operate a process continuously. *In re Dilnot* 138 USPQ 248; *In re Korpi* 73 USPQ 229; *In re Lincoln* 53 USPQ 51; and MPEP § 2144.04(E).

Applicant states that the independent claims have been amended to recite a method that consists essentially of the recited steps. As previously noted, Drzal et al. teach a two-step process including the application of water in an effort to cool the substrate to avoid deleterious heating of the surface of the substrate. As such, the prior art methods referenced by the examiner, such as Drzal et al. that disclose a two-step process including a required cooling step or a required cleaning step do not read upon the present claim. The claimed process is much more efficient with respect to time and expense. In view of the amendments to the claims, it is respectfully submitted that the claims do not read on the two-step processes disclosed by the prior art of record and

Art Unit: 1753

that the present rejection is now moot.

In response, the claims as presently written are open to a cooling step and/or a cleaning step. The phrase "consisting essentially of" limits the scope of a claim to the specified steps and those that do not materially affect the basic and novel characteristic of a method. When Applicant contends that modifying steps in the reference method are excluded by the recitation of "consisting essentially of", Applicant has the burden of showing the basic and novel characteristics of his method, i.e., a showing that the introduction of these steps would materially change the characteristics of Applicant's method. *In re Lajarte* 337 F 2d 870, 143 USPQ 256 (CCPA 1964).

Furthermore, instead of water, Drzal teaches providing humidity in the air adjacent to the surface to be modified prior to irradiating the surface to modify the surface (col. 9, lines 19-27; and col. 28, lines 50-55) [see also present claim 31].

Applicant states that it is respectfully submitted, however, that pulsing light is something that occurs in less than 0.1 second and that the present invention claims continuous radiation, which is not taught in any of the cited references.

In response, Drzal teaches a 30 sec on/ 30 sec off pulsed (col. 18, line 25). Drzal teaches a continuous radiation. Drzal teaches that the light can be pulsed or continuous (abstract).

II. Claims 108-112 have been rejected under 35 U.S.C. 103(a) as being

Art Unit: 1753

unpatentable over **Drzal et al.** (US Patent No. 6,565,927 B1) as applied to claims 92-97, 101-107 and 113-114 above, and further in view of **Cates et al.** (US Patent No. 5,512,123) and **Elliott et al.** (US Patent No. 5,669,979).

The rejection of claims 108-112 under 35 U.S.C. 103(a) as being unpatentable over Drzal et al. as applied to claims 92-97, 101-107 and 113-114 above, and further in view of Cates et al. and Elliott et al. is as applied in the Office Actions dated June 3, 2005 and January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

III. Claims **115, 119 and 120** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Drzal et al.** (US Patent No. 6,565,927 B1).

The rejection of claims 115, 119 and 120 under 35 U.S.C. 103(a) as being unpatentable over Drzal et al. is as applied in the Office Actions dated June 3, 2005 and January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

IV. Claims **121-123** have been rejected under 35 U.S.C. 103(a) as being



Art Unit: 1753

unpatentable over **Drzal et al.** (US Patent No. 6,565,927 B1).

The rejection of claims 121-123 under 35 U.S.C. 103(a) as being unpatentable over under 35 U.S.C. 103(a) as being unpatentable over Drzal et al. is as applied in the Office Actions dated June 3, 2005 and January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**V.** Claims **124-127** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Drzal et al.** (US Patent No. 6,565,927 B1) as applied to claims 121-123 above, and further in view of **Cates et al.** (US Patent No. 5,512,123) and **Elliott et al.** (US Patent No. 5,669,979).

The rejection of claims 124-127 under 35 U.S.C. 103(a) as being unpatentable over Drzal et al. as applied to claims 121-123 above, and further in view of Cates et al. and Elliott et al. is as applied in the Office Actions dated June 3, 2005 and January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**VI.** Claims **128-132 and 134-135** have been rejected under 35 U.S.C. 103(a) as

being unpatentable over **Drzal et al.** (US Patent No. 6,565,927 B1).

The rejection of claims 128-132 and 134-135 under 35 U.S.C. 103(a) as being unpatentable over Drzal et al. is as applied in the Office Actions dated June 3, 2005 and January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**VII.** Claim **133** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **Drzal et al.** (US Patent No. 6,565,927 B1) as applied to claims 128-132 and 134-135 above, and further in view of **Cates et al.** (US Patent No. 5,512,123) and **Elliott et al.** (US Patent No. 5,669,979).

The rejection of claim 133 under 35 U.S.C. 103(a) as being unpatentable over Drzal et al. as applied to claims 128-132 and 134-135 above, and further in view of Cates et al. and Elliott et al. is as applied in the Office Actions dated June 3, 2005 and January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**VIII.** Claims **101-107** and **111-112** have been rejected under 35 U.S.C. 103(a) as

being unpatentable over **DE 36 31 123 A1** ('123) as applied to claims 92-94 above.

The rejection of claims 101-107 and 111-112 under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1** ('123) as applied to claims 92-94 above is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**IX.** Claims **108-110 and 113-114** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1** ('123) as applied to claims 92-94 above, and further in view of **Cates et al.** (US Patent No. 5,512,123) and **Elliott et al.** (US Patent No. 5,669,979).

The rejection of claims 108-110 and 113-114 under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1** ('123) as applied to claims 92-94 above, and further in view of **Cates et al.** and **Elliott et al.** is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**X.** Claims **115, 119 and 120** have been rejected under 35 U.S.C. 103(a) as being

unpatentable over **DE 36 31 123 A1** ('123).

The rejection of claims 115, 119 and 120 under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1** ('123) is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**XI.** Claims **121-123** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1** ('123).

The rejection of claims 121-123 under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1** ('123) is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**XII.** Claims **124-127** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1** ('123) as applied to claims 121-123 above, and further in view of **Cates et al.** (US Patent No. 5,512,123) and **Elliott et al.** (US Patent No. 5,669,979).

The rejection of claims 124-127 under 35 U.S.C. 103(a) as being unpatentable over DE 36 31 123 A1 ('123) as applied to claims 121-123 above, and further in view of Cates et al. and Elliott et al. is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**XIII. Claims 128-132 and 134-135** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1 ('123)**.

The rejection of claims 128-132 and 134-135 under 35 U.S.C. 103(a) as being unpatentable over DE 36 31 123 A1 ('123) is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**XIV. Claim 133** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **DE 36 31 123 A1 ('123)** as applied to claims 128-132 and 134-135 above, and further in view of **Cates et al.** (US Patent No. 5,512,123) and **Elliott et al.** (US Patent No. 5,669,979).

The rejection of claim 133 under 35 U.S.C. 103(a) as being unpatentable over DE 36 31 123 A1 ('123) as applied to claims 128-132 and 134-135 above, and further in view of Cates et al. and Elliott et al. is as applied in the Office Action dated January 18, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

### ***Response to Amendment***

#### ***Claim Objections***

Claims **123-124 and 126** are objected to because of the following informalities:

#### **Claim 123**

line 2, is the "the active zone adjacent to the conveyor system" the same as the active zone proximate the conveyor recited as recited in claim 121, line 6? If so, then it is suggested that the word "adjacent" be amended to the word -- proximate --.

#### **Claim 124**

line 6, the word "an" should be amended to the word -- the --. See claim 124, lines 2-3.

Claim 126

line 2, is the "the active zone adjacent to the conveyor system" the same as the active zone proximate the conveyor recited as recited in claim 121, line 6? If so, then it is suggested that the word "adjacent" be amended to the word -- proximate --.

Appropriate correction is required.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

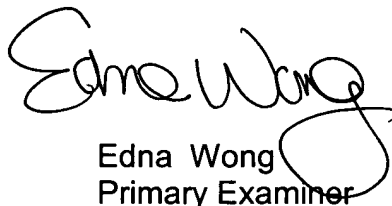
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

Art Unit: 1753

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
August 17, 2006